

REMARKS

Applicants have considered the outstanding official action. It is respectfully submitted that the claims are directed to patentable subject matter as set forth below.

The outstanding rejections are as follows:

- (1) Claims 1-12 under 35 U.S.C. §102(b) over U.S. Patent No. D447,408 (Humphrey);
- (2) Claims 1-4, 7-12, 15 and 16 under 35 U.S.C. §102(e) over U.S. Patent No. D467,494 (Udwin);
- (3) Claims 1-10 under 35 U.S.C. §102(b) over U.S. Patent Application Publication No. US 2001/0007308 (Glassman); and
- (4) Claims 13 and 14 under 35 U.S.C. §103(a) over U.S. Patent No. 4,781,289 (Perkins).

As to the rejections under 35 U.S.C. §102 over individually Humphrey, Udwin and Glassman, independent claims 1 and 2 have each been amended to read that "said depth of said at least a portion of said first outward projecting portion is equal to a greatest depth of an outermost projecting portion of said at least one additional outward projecting portion so that said package is self-indexing". None of Humphrey, Udwin or Glassman teach such a structure. Each of Humphrey, Udwin and Glassman describe a

package having a bottom portion which extends outward further than any other portion extending outward, i.e., the bottom portion has a depth greater than the depth of the other outward extending portion. Accordingly, none of Humphrey, Udwin or Glassman teach each and every element of the claimed package or blister pack and, thus, does not anticipate the claimed invention under 35 U.S.C. §102. Withdrawal of each of the §102 rejections is therefore respectfully requested.

The sole remaining rejection is of claims 13-14 under 35 U.S.C. §103 over Perkins.

Perkins describes a display package adapted to stand alone on a horizontal surface (column 4, lines 9-10). While Perkins states that the depth of the support structure 22 should be comparable to the depth of the product enclosure 20 to prevent the package from falling over, no teaching or suggestion is set forth to provide a bottom portion or foot equal in depth to an additional projecting portion of the package so that the package is self-indexing, i.e., provides predetermined spacing between it and another aligned package (see applicants' specification at page 5, lines 4-6) which is a separate structural feature from providing a package able to stand alone. That Perkins provides no suggestion as to this feature is evident from Figure 3 illustrating the package of Perkins wherein the

product enclosure 20 extends further outward than the support structure 22. As described by applicants, to be self-indexing, the depth of the foot over at least a portion thereof is equal to or greater than the greatest depth of the article compartment and that optimum indexing is provided when the depths are equal (see applicants' specification at page 10, line 28 to page 11, line 8). Perkins teaches away from this claimed feature and, thus, no suggestion is provided.

The Examiner asserts, inter alia, that "equal is mere extrapolation of the Perkins teachings" and that the "dimensional construction of Perkins is no different than Applicant's self-indexing package alignment" since "Perkins' desire not to use unnecessary valuable shelf-space by leading one skilled in the art to make portions 20 and 22 of equal depth has the effect of creating organized indexed appearance". Applicants respectfully submit that such is mere speculation since there is no basis from the teachings of Perkins for one skilled in the art to modify Perkins to achieve applicants' claimed structure. Perkins, as set forth above leads in the opposite direction as to length of the support structure 22. Perkins does not recognize any problem as to self-indexing or desire to provide a structure which is self-indexing. As to the described ability to stand alone or to take up minimal shelf space, each of these

ends can be achieved by a structure as shown in Humphrey, Udwin or Glassman wherein the base portion allows the package to stand alone and yet the base portion extends beyond the article portion as in Figure 3 of Perkins.

While as set forth by the Examiner, blister packs are well known and can be modified, no teaching or suggestion is provided in the applied art to modify such to provide the claimed structure of applicants. Applicants respectfully submit that if the claimed self-indexing structure was so well-developed in the art that an explicit teaching or suggestion thereto would be present in the art.

It is now well settled that a rejection under 35 U.S.C. §103 must rest on a firm factual basis and that the Examiner has the initial duty of providing that factual basis. Deficiencies in the factual basis cannot be supplied by resorting to speculation or unsupported generalities. In re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967) and In re Freed, 425 F.2d 785, 165 USPQ 570 (CCPA 1970).

Further, the mere fact that the prior art can be modified does not make the modification obvious unless the prior art suggests the desirability of the modification. In re Gordon, 733 F.2d 900, 902; 221 USPQ 1125 (Fed. Cir. 1984). Once applicants' solution to a problem is disclosed, it is easy to see how prior references can be modified and manipulated to produce the claimed invention. The change

can appear simple and by hindsight seem obvious. However, as stated by the Court in In re Sporck, 133 USPQ 360, 363 (CCPA 1962), the simplicity of new inventions is oftentimes the very thing that is not obvious before they are made. The Court goes on to cite as support In re Osplack, 195 F.2d 921, 93 USPQ 306, 308 (CCPA 1952) stating -

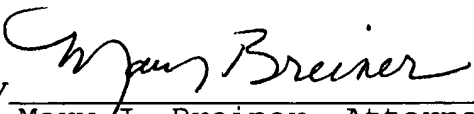
"We think this case is one of that category of inventions which, when viewed after disclosure and explanation by an applicant, seem simple and such as should have been obvious to those in the field. Yet this does not necessarily negative invention or patentability. [citations omitted]. Indeed, simplicity may even be some evidence of invention. [citations omitted]."

Accordingly, Perkins does not teach or suggest each element of the claimed invention and, thus, does not render the claimed invention obvious within the meaning of 35 U.S.C. §103. Withdrawal of the §103 rejection therefore is respectfully urged.

Reconsideration and allowance of the claims is respectfully requested.

Respectfully submitted,

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